non-actual dimension of a feature on a drawing determined by the second edge in the second linear scale corresponds directly to an actual dimension of the feature determined by the first edge in the first linear scale.

Hellar purport to relate to a measuring tape that provides for quick determination of the center of a distance without requiring the calculation of the distance. Hellar states that the measuring tape includes two parallel edges and an ascending measuring scale along each edge printed on the same face of the tape and beginning at the same end of the tape. Hellar also states that one of the scales has units calibrated to a conventional unit of length measurement. According to Hellar, the second measuring scale has units calibrated to be exactly half the unit of the first scale.

With respect to claim 1, the Final Office Action maintains that "Hellar teaches a measuring device (1) comprising: a first edge (2) defining a first region, said first region having a first set of indicia (8) corresponding to a first linear scale, wherein said first linear scale is actual (Col. 2, lines 61-65); a second edge (3) defining a second region, said second region having a second set of indicia (9) corresponding to a second linear scale, wherein said second linear scale is non-actual (Col. 2, lines 65-67), such that a non-actual dimension determined by the second edge in the second linear scale corresponds directly to an actual dimension determined by the first edge in the first linear scale (Col. 2, lines 61-67, the second linear scale is half-scale)." Final Office Action at page 2.

It is respectfully submitted that Hellar fails to disclose, or even suggest, a measuring device that includes a first, actual, linear scale, and a second, non-actual, linear scale such that a non-actual dimension of a feature on a drawing determined in the second linear scale corresponds directly to an actual dimension of the feature determined in the first linear scale, as recited in amended claim 1. The present invention describes at page 14, lines 6 to 18 of the Specification that:

> "... instead of using a conventional ruler to measure the length
> of the wall on the drawing ... and then performing a conversion
> to determine the length of the wall in actuality, the numerical
> values 26b of device 10 clearly show the user that the length
> of the wall as shown on the drawing is [, e.g.,] 20 feet, because

the indicia 22b of region 20b have numerical values 26b that correspond to the scaled distance. The need for performing a conversion step is thereby eliminated. Upon determining the distance shown on the drawing, <u>the user can then use the indicia 22a of measuring device 10 corresponding to the actual linear scale to position the wall in actuality.</u>" (emphasis added).

Thus, amended claim 1 provides a single measuring device that can determine corresponding measurements in both a first, actual, linear scale and a second, non-actual, linear scale, enabling a user to measure a dimension of a feature on a drawing drawn to scale, and to make a corresponding measurement of the feature in actuality. In contrast, Hellar describes a tape measure that determines a <u>centerpoint</u> of a distance. Specifically, Hellar describes that the device described therein may be used "to locate and hang a picture at the centerpoint between the proximate vertical edges 50, 52 of a pair of windows 54, 56 in a wall 58 of a room." Column 3, lines 45 to 48. Hellar states that "the beginning end 33 of the tape is placed against one of the vertical edges (e.g., edge 52) and the tape is extended to the other vertical edge [and that] indicia corresponding to the distance D between these vertical edges 50, 52 is located on the full scale." Column 3, lines 48 to 53. Hellar also states that "[t]his same indicia is then located on the half scale edge of the tape and will be at a distance D' which is one-half of the distance D [and in] this manner, the centerpoint between the windows is located and a picture may be hung at such location." Column 3, line 53 to column 4, line 2. Thus, the two dimensions determined by the tape measure of Hellar, a first dimension and a second dimension that is equal to half of the first dimension, do not directly correspond to each, but are intended to be <u>different</u> dimensions, namely a full distance and half of that full distance. Furthermore, the two scales of the device of Hellar is described as being employed to measure these two different dimensions of the <u>same</u> object or feature, not to measure a dimension of a feature on a drawing and a dimension of the actual feature, as recited in amended claim 1.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. <u>Verdegaal Bros. v. Union Oil Co. of Calif.,</u> 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he

identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Hellar does not disclose, or even suggest, a measuring device that includes a first, actual, linear scale, and a second, non-actual, linear scale such that a non-actual dimension of a feature on a drawing determined in the second linear scale corresponds directly to an actual dimension of the feature determined in the first linear scale, as recited in amended claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Hellar does not anticipate

claim 1.

As for claims 2 to 9, which ultimately depend from claim 1, it is respectfully submitted that Hellar does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

III. Rejection of Claims 1, 10 and 11 Under 35 U.S.C. § 102(b)

Claims 1, 10 and 11 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,230,158 ("Wall"). Applicants respectfully submit that Wall does not anticipate the present claims for the following reasons.

Wall purports to describe a tape measure for use with roof framing members. According to Wall, the tape measure has a true distance scale having true distance indicia indicating feet, inches and fractions of inches, and one or more secondary false distance scales having false distance indicia corresponding to the true distance indicia. Wall states that the actual distances between false distance indicia is the true distance between the true distance indicia multiplied by a predetermined pitch factor. Wall further states that the false distance indicia allow direct marking of the proper rafter lengths for common, hip, valley and jack rafters for a given pitch roof after measurement of the run distance using the true distance scale, without need of calculation or of knowledge of the actual rafter length.

In support of the present rejection, the Final Office Action states that "Wall teaches a measuring device (10) comprising: a first edge (11) defining a first region, said first region having a first set of indicia (20) corresponding to a first linear scale, wherein said first linear scale is actual (Col 4, lines 41-54); a second edge (12) defining a second region, said second region having a second set of indicia (30) corresponding to a second linear scale, wherein said second linear scale is non-actual, such that a non-actual dimension determined by the second edge in the second linear scale corresponds directly to an actual dimension determined by the first edge in the first linear scale (Col 4, lines 17-40 and 55-68)." Final Office Action at page 3.

It is respectfully submitted that Wall does not anticipate claim 1 for at least the reason that Wall does not disclose, or even suggest, all of the features recited in

claim 1. For example, Wall fails to disclose, or even suggest, a measuring device that includes a first, actual, linear scale, and a second, non-actual, linear scale such that a non-actual dimension of a feature on a drawing determined in the second linear scale corresponds directly to an actual dimension of the feature determined in the first linear scale, as recited in amended claim 1. Rather, Wall describes one measurement as being an actual length of a run of a roof, and other measurements as being the lengths for various different rafters that could be used in a roof having a run of such length. Specifically, Wall describes that "[t]he device comprises four separate scales, with all four scales having a common starting or zero point at the free end of the tape." Column 2, lines 34 to 36. Wall further states that "[o]ne scale is a true distance scale with indicia setting forth the feet, inches, and fractions in the conventional manner using lines of varying length and numbers [and the] other three scales are false distance scales and are used for determining the correct length of the rafters which are to be cut [, i.e.,] the correct length for a common rafter, hip jack rafter or valley jack rafter[,] a hip or valley rafter length [and] the proper rise height for a given pitch." Column 2, lines 36 to 48. Wall further states that "[t]he difference between the distances is determined by a multiplication factor inherent to a particular roof pitch, as determined by applying the Pythagorean theorem and other necessary calculations." Column 2, lines 51 to 55. Thus, the second measurement of Wall is not scaled, but is determined by non-linear, trigonometric factors such as "the Pythagorean theorem and other necessary calculations." Furthermore, the two measurements determined by the device of Wall, a first measurement of an actual length of a roof and a second measurement of different rafter lengths to fit that roof length, do not directly correspond to each, but are intended to be different by various different multiplication factors.

Therefore, for at least the reasons stated above, it is respectfully submitted that Wall does not anticipate claim 1.

As for claims 10 and 11, which ultimately depend from claim 1, it is respectfully submitted that Wall does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

IV. Rejection of Claim 12 Under 35 U.S.C. § 102(b)

Claim 12 was rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,484,395 ("Samuels"). Applicants respectfully submit that Samuels does not anticipate the present claims for the following reasons.

Claim 12 relates to a method for measuring. Claim 12 has been amended to recite that the method includes the step of positioning a measuring device on a drawing, said measuring device having a first set of indicia corresponding to a first, actual linear scale and a second set of indicia corresponding to a second, non-actual linear scale, wherein said drawing has features sized in said second, non-actual linear scale. Claim 12 has been amended to recite that the method includes the step of using said second set of indicia, determining a first, non-actual length measurement of a feature on said drawing. Claim 12 has also been amended to recite that the method includes the step of using said first set of indicia, determining a second, actual length measurement on an object, wherein said first, non-actual length measurement and said second, actual length measurement correspond to the same actual dimension.

In support of the present rejection, the Final Office Action states that "Samuel[ ] teaches a method for measuring, comprising the steps of: positioning a measuring device on a drawing (Col. 1, lines 5-24), said measuring device (10) having a first set of indicia (9) corresponding to a first linear scale and a second set of indicia (8) corresponding to a second linear scale, wherein said drawing has features sized in a second linear scale (Col 1, lines 5-24); using said second set of indicia, determining a first length of measurement of a feature on said drawing (Col 1, lines 5-24); using said first set of indicia, determining a second length measurement on an object, wherein said first length measurement and said second length measurement correspond to the same actual dimension (Col 7-17 and lines 40-57)." Final Office Action at page 4.

Samuels purports to disclose a scale for use in making direct measurements in feet and inches on blue prints and the like drawn in various reduced scales. Samuels states that the scale features special inch character markings throughout the length of the scale to enable the user to directly read measurements in inches between corresponding foot measurements. Samuels further states that the

markings include 3, 6 and 9 inch subdivision and character markings with 6 inch markings for the smallest scale contemplated.

It is respectfully submitted that Samuel does not anticipate amended claim 12 for at least the reason that Samuels does not disclose, or even suggest, all of the features recited in amended claim 12. For example, Samuels fails to disclose, or even suggest, a method for measuring that includes the steps of determining a first length measurement of a feature on a drawing using a device having a second, non-actual, linear scale and determining a second length measurement on an object using a first, actual, linear scale, wherein the first length measurement and the second length measurement correspond to the same actual dimension, as recited in amended claim 12. Rather, Samuels describes a blue print scale that has various non-actual linear scale, each having inch markings therebetween. Specifically, Samuels states that "it is an object of the present invention to provide such a reduced measuring scale in which such effort is not required by the user to alleviate the source of errors and to facilitate the making of direct measurements on reduced scale drawings as described." Col. 1, lines 43 to 47. Thus, any two measurements determined by the device of Samuels are both non-actual.

Therefore, for at least the reasons stated above, it is respectfully submitted that Samuels does not anticipate claim 12.

V.   Conclusion

Attached hereto is a marked-up version of the changes made to the claims by the current Reply Under 37 C.F.R. §1.116. The attached page is captioned **"Version with Markings to Show Changes Made."**
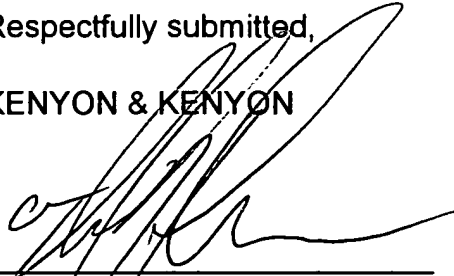
It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: June 11, 2003   By: _____

Thomas C. Hughes
Reg. No. 42,674

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646
26646
26646
PATENT TRADEMARK OFFICE

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 1 and 12 have been amended without prejudice as follows:

1. (Twice Amended) A measuring device comprising:

a first edge defining a first region, said first region having a first set of indicia corresponding to a first linear scale, wherein said first linear scale is actual;

a second edge defining a second region, said second region having a second set of indicia corresponding to a second linear scale, wherein said second linear scale is non-actual, such that a non-actual dimension of a feature on a drawing determined by the second edge in the second linear scale corresponds directly to an actual dimension of the feature determined by the first edge in the first linear scale.

12. (Amended) A method for measuring, comprising the steps of:

positioning a measuring device on a drawing, said measuring device having a first set of indicia corresponding to a first, actual linear scale and a second set of indicia corresponding to a second, non-actual linear scale, wherein said drawing has features sized in said second, non-actual linear scale;

using said second set of indicia, determining a first, non-actual length measurement of a feature on said drawing;

using said first set of indicia, determining a second, actual length measurement on an object, wherein said first, non-actual length measurement and said second, actual length measurement correspond to the same actual dimension.